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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,644	04/17/2000	JOERG SCHWENK	2345/122	8596

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EXAMINER
DEMICCO, MATTHEW R

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 07/14/2004   *10*

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.		Applicant(s)
Office Action Summary	09/529,644		SCHWENK ET AL.
	Examiner		Art Unit
	Matthew R Demicco		2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 May 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15-33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This action is responsive to an amendment filed 5/3/04. Claims 15-33 are pending. Claim

33 is amended. The 35 U.S.C. 112 rejection of Claim 33 is hereby withdrawn in light of the

amendment.

Response to Arguments

2.   Applicant's arguments filed with respect to Claims 15, 17, 24, 30, 31 and 33 have been

fully considered but they are not persuasive. Applicant argues that Kahn does not teach buffering

data using the terminal, establishing communication with the mobile data carrier, or routing data

to and storing data on the carrier. Further, Applicant argues that Kahn does not identically teach

the "features of a communication apparatus" or a memory buffer.

With respect to Applicant's argument regarding buffering data using the terminal, as

stated in the last Office Action, Kahn discloses storing received authorization information,

receiving subsequent conditional information, processing the conditional information, then

updating the authorization map based on the received data (Col. 7, Line 64 – Col 8, Line 29).

The initial storage of the received authorization data in a memory before the data is actually

tested and put into effect reads on the claimed memory for use as a list so as to buffer data

transmitted from a transmitter to a device. Further, Kahn discloses the use of a memory to

"temporarily store data during the processing of the digital downlink signal to provide the

program content." (Col. 5, Lines 1-11). The American Heritage Dictionary, 4th Edition states that

a "buffer" is, "a device or area used to store data temporarily." Further, the Dictionary discloses

"buffering" as, "to hold or collect (data) in a buffer." The memories for temporarily storing data

of Kahn clearly read on the claimed buffer.

With respect to Applicant's argument regarding establishing communication with the

mobile data carrier, routing the data to the carrier and storing the data, Kahn discloses

temporarily storing received data in a buffer as stated above. Kahn further discloses storing

authorization information on the replaceable secure authorization card (Col. 5, Lines 9-35) after

performing a test on the data (Col. 8, Lines 1-29). This clearly reads on storing the data. In order

for a computer device to communicate with the replaceable card, there must inherently be

communication established and data transferred. If this step were not performed, it would simply

be impossible to utilize the authorization card in any way. This clearly reads on the claimed

establishing communication with and routing data to the mobile data carrier.

Regarding Applicant's argument that Kahn does not disclose all the limitations of Claim

24, the Examiner points out that Kahn discloses a device with a microprocessor (See Figure 3).

This reads on the claimed control and evaluation electronics. Kahn further discloses

communicating with a mobile data carrier as stated above. It is inherent that there be an interface

between the microprocessor and the data carrier for without one communication between the

devices would be impossible and the system would not work as disclosed by Kahn. Also

disclosed are memories (See Figure 3) for buffering data as stated above. The Examiner

maintains that Kahn meets all the features of the claimed invention.

With respect to Applicant's objection to the Examiner's use of inherency, the Examiner

has fully disclosed how each inherent characteristic *necessarily* exists in the teachings of Kahn as

stated above.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 15-19, 21-22, 24-31 and 33 are rejected under 35 U.S.C. 102(b) as being

anticipated by U.S. Patent No. 5,978,649.

Regarding Claim 15, Kahn discloses a method for routing data in a pay television

terminal (See Figure 1, Direct Broadcast Satellite system), the data including receiving

rights (Col. 6, Lines 7-14) for a mobile data carrier (Col. 5, Line 8, "replaceable secured

authorization card"). Kahn further discloses the transmission of the data from a

transmitter (See Figure 1) via a transmission medium to the pay-TV terminal (Col. 3,

Lines 61-65). The data is buffered at the terminal (Cols. 4-5, Lines 66-10 and Cols. 7-8,

Lines 64-29) as stated above in the Response to Arguments. Communication between the

mobile data carrier and the terminal is established and the receiving data is routed and

stored in the mobile data carrier (Col. 6, Lines 30-39). Kahn discloses that each secure

authorization card may be individually addressed based on a stored identification number

in memory (Col. 6, Lines 30-39). The data destined for other terminals is still received

prior to identification determination of the received data (Col. 1, Lines 13-30) and must

be buffered as stated above. This data reads on the claimed data including at least second

receiving rights for a second mobile data carrier.

Regarding Claim 16, Kahn discloses a method as stated above in Claim 15 wherein the first mobile data carrier includes a chip-card (Col. 5, Line 8, "replaceable secured authorization card").

Regarding Claim 17, Kahn discloses a method for routing data in a pay television terminal (See Figure 1, Direct Broadcast Satellite system), the data including receiving rights (Col. 6, Lines 7-14) for a mobile data carrier (Col. 5, Line 8, "replaceable secured authorization card"). Kahn further discloses the transmission of the data from a transmitter (See Figure 1) via a transmission medium to the pay-TV terminal (Col. 3, Lines 61-65). The data is buffered at the terminal (Cols. 4-5, Lines 66-10 and Cols. 7-8, Lines 64-29) as stated above in the Response to Arguments. Communication between the mobile data carrier and the terminal is established and the receiving data is routed and stored in the mobile data carrier (Col. 6, Lines 30-39). Kahn further discloses that each secure authorization card may be individually addressed based on a stored identification number in memory (Col. 6, Lines 30-39). This reads on the claimed storing in a list a respective chip card number for at least one of the chipcard so as to enable the pay TV terminal to cooperate with at least one chipcard. This identification number for addressing individual cards further reads on the claimed chipcard-specific filter information.

Regarding Claim 18, Kahn discloses a method as stated above in Claim 17. Further, it is inherent that the length or composition of a list must be either variable or fixed since all lists are either one or the other but not both.

Regarding Claim 19, Kahn discloses a method as stated above in Claim 17 wherein data is stored based on conditional rules received by the set top box from the service provider as stated above. This process requires no user intervention. This reads on the claimed automatic storing being performed according to fixed rules using the pay TV terminal.

Regarding Claim 21, Kahn discloses a method as stated above in Claim 17 chipcard numbers and consequently the respective chipcard-specific filter information is transmitted to the pay TV terminal via the transmission medium (Col. 6, Lines 30-39).

Regarding Claim 22, Kahn discloses a method as stated above in Claim 15 further comprising transmitting filter information (Col. 6, Lines 18-30) to the pay TV terminal using the mobile data carrier upon establishing communication. It is further inherent that in such a system where authorization information is stored on a removable card that the information must be read by the terminal in order for to access user privileges for channel selection and tuning stored thereon.

Regarding Claim 24, Kahn discloses a device for decoding pay-TV programs comprising control and evaluation electronics (See Figure 3, "microprocessor"), a communication apparatus for communicating with a first mobile data carrier via an interface (Col. 5, Line 8, "replaceable secured authorization card"), a memory for use as a list to buffer data transmitted from a transmitter to the device (Col. 6, Lines 18-30) via a transmission medium (See Figure 1) using the control and evaluation electronics, at least a first portion of the buffered data being routed immediately to the first mobile data carrier (Col. 6, Lines 30-39).

Regarding Claim 25, Kahn discloses a device as stated above in Claim 24 further comprising a pay-TV terminal (See Figure 1, Direct Broadcast Satellite system and Figure 2, Terminal 38).

Regarding Claim 26, Kahn discloses a device as stated above in Claim 24 wherein the first mobile data carrier includes a chip-card (Col. 5, Line 8, "replaceable secured authorization card").

Regarding Claim 27, Kahn discloses a device as stated above in Claim 24 wherein the data includes receiving rights (Col. 6, Lines 7-30).

Regarding Claims 28 and 29, Kahn discloses a device as stated above in Claim 24 wherein the memory is a non-volatile EEPROM (Col. 5, Line 4).

Regarding Claim 30, Kahn discloses a device for decoding pay TV programs as stated above. Further, the system of Kahn utilizes a mobile data carrier as stated above. It is inherent that the communication device for communicating with the mobile data carrier would be able to communicate with any suitably operable chip card that was inserted since the entire purpose of using a removable data carrier is the ability to utilize different cards. This reads on the claimed communication device being for communicating with a first mobile data carrier and with a second mobile data carrier. Further, as stated above in Claim 15, the communication device is operable to receive a broadcast of data and determine which data is intended for the mobile data carrier that is in use. Based on the chip card that is in use, data will either be stored or discarded. This reads on the claimed control module for performing an allocation respectively between the first portion and

second portion of the buffered data (used and unused data) and the first and second

mobile data carriers

Regarding Claim 31, Kahn discloses a device for decoding pay TV programs as

stated above. Kahn further discloses that the communication device is for communicating

with a first and second mobile data carrier as stated above in Claim 30. The system must

communicate with the inserted mobile data carrier in order to store updated information

using individual addressing as stated above. This reads on the claimed evaluation

electronics including an evaluation module for determining which mobile data carrier is

in communication with the terminal. Based on the identification of the inserted card, the

received and buffered data is routed accordingly.

Regarding Claim 33, Kahn discloses a device for decoding pay TV programs as

stated above. Authorization data for multiple channels may be received (Col. 2, Lines 32-

35 and Col. 6, Lines 40-44)). This reads on the claimed first and second data portions

respectively include first and second receiving rights.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 20, 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kahn.

Regarding Claim 20, Kahn discloses a method as stated above in Claim 17. What is not disclosed, however, is that the storing is performed manually. Official Notice is hereby taken that it is well known in the art of data storage that a user may have to insert a portable data storage device into a receptacle and confirm a write operation. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Kahn with the user intervention of the well-known prior art in order to allow a user to update a personal access card that is not left unattended in a receiver.

Regarding Claim 23, Kahn discloses a method as stated above in Claim 17. What is not disclosed, however, is deleting the receiving rights using a pre-selected prioritization if a size of the list is exceeded. Official Notice is hereby taken that it is well known in the art to use a priory-based deletion scheme to delete older or less important data from a memory of finite size when the memory becomes full. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Kahn with the deletion of the well-known prior art in order to prevent newer or more important information from being lost when a memory device is full.

Regarding Claim 32, Kahn discloses a device as stated above. . What is not disclosed, however, is a priority circuit for determining which of the first portion of the buffered data and a second portion of the data are deleted upon exceeding of a space in the memory. Official Notice is hereby taken that it is well known in the art to use a priory-based deletion scheme to delete older or less important data from a memory of

finite size when the memory becomes full. Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to modify the method

of Kahn with the deletion of the well-known prior art in order to prevent newer or more

important information from being lost when a memory device is full.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155.

The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mrd
June 28, 2004

VIVEK SRIVASTAVA
PRIMARY EXAMINER